

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

20496-491

Application Number

10/551,871

Filed

Nov. 16, 2006

First Named Inventor

Aachen Lars Dohse

Art Unit

3611

Examiner

Islam, Syed A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 55,699

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Deborah M. Vernon
Signature

Deborah M. Vernon
Typed or printed name

617-526-9836
Telephone number

July 10, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 2 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Dohse et al. CONFIRMATION NO.: 2028
APPLICATION NO.: 10/551,871 GROUP NO.: 3611
FILING DATE: November 16, 2006 EXAMINER : Islam, Syed A.
TITLE: MEANS FOR FASTENING OR FOR CLAMPING GOODS, AND
INFORMATION MEDIUM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the Final Office Action mailed January 12, 2009. This Request is filed concurrently with a Notice of Appeal, and no amendments are being filed with this Request. The review is requested for reasons provided below.

Applicants hereby authorize the Commissioner to charge any fee that may be due in this application to Attorney's Deposit Account No. 50-3081.

Applicants respectfully request entry of this paper, in which:

Remarks begin on page 2.

REMARKS

In the Final Office Action mailed January 12, 2009, claims 1-24 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,105,295 to Brinkman et al. ("Brinkman"), U.S. Patent No. 6,632,042 to Liener Chin et al. ("Liener Chin"), and U.S. Patent No. 4,773,175 to Larsen ("Larsen").

Applicants note that claims 1 and 24 are written in independent form, and claims 2-23 depend therefrom. Applicants submitted Amendment After Final Rejection on June 29, 2009 to amend dependent claims 2-4 and 23 pursuant to 37 C.F.R. § 1.116, to present these claims in better form for consideration on appeal, and to comply with the Examiner's requirement of form expressly set forth in a previous Office action.

Together with the reasons presented below, Applicants submit that the Examiner has failed to establish a proper rejection under 35 U.S.C. § 103(a).

I. The Final Office Action Is Based Upon Clear Factual Deficiencies

Applicants submit that the Final Office Action is based upon several clear factual deficiencies and thus is improper. For example, the Final Office Action erroneously identified that in Brinkman the cover **20** is an information medium.

Brinkman's element **20** is "a generally planar transparent cover." Brinkman at col. 3, ll. 65-66. Brinkman specifically requires the cover **20** "preferably being formed of a transparent polyvinyl chloride, to enable a non-adhesive paper or plastic label 25 (see FIG. 6) to be ... viewed through the transparent cover 20." Brinkman at col. 4, ll. 3-10. By contrast, Applicants' claimed information medium consists of at least one identification medium, an insert having high tear strength, and a protective casing, which surrounds at least the identification medium, and is joined as a unit. Applicants' specification as originally filed at top of p. 3. Thus Brinkman's element **20**, a transparent cover, clearly lacks at least one identification medium and an insert having high tear strength.

In the event that this prosecution proceeds to a full appeal brief, Applicants reserve their right to discuss other clear factual deficiencies in the Final Office Action, such as, for example, the Examiner's characterization of Brinkman's "channel gripping member **60**" as Applicants' claimed means for fastening, securing, or clamping goods, and Brinkman's "label **25**" as Applicants' identification medium.

At least because Brinkman's element **20** was erroneously equated to Applicants' claimed information medium, Applicants respectfully submit that the Final Office Action is improper as the rejection is based upon a clear factual deficiency, resulting in a rejection that fails to properly account for Applicants' claimed information medium. Accordingly, Applicants respectfully request that the rejection be withdrawn.

II. The Final Office Action Fails To Establish A *Prima Facie* Case Of Obviousness Under 35 U.S.C. §103(a)

The Final Office Action fails to support a *prima facie* case of obviousness at least because Brinkman, Liener Chin, and Larsen in combination fail to teach or suggest all of the elements of Applicants' claims. MPEP §706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

With regard to claim 1, the three references combined do not teach or suggest means for fastening, securing or clamping goods or for securing a person, with an information medium **permanently attached** thereto. For example, Brinkman discloses "label holder for displaying information-containing non-adhesive labels or signs on a channel member." Brinkman at col. 2, ll. 52-55. However, Brinkman's label holder is "removably secured to the channel member" such that it can "be easily engaged between, and removed from... the channel member." Brinkman at col. 4, ll. 59-66 and col. 6, ll. 5-8. Liener Chin teaches sheet protector pocket having binder holes, where "[t]he user removes the dividers and pocket from the packaging." Liener Chin at Abstract. Larsen teaches shopping cart display boards and states: "the utilization of the apparatus of the present invention is advantageous since it is easily installed and easily removed from a shopping cart." Larsen at Abstract and col. 10, ll. 7-9. Therefore, each of the references not only fails to teach, but also explicitly **teaches away** from Applicants' means for fastening, securing or clamping goods or for securing a person, with an information medium **permanently attached**.

In addition, Brinkman, Liener Chin, and Larsen combined fail to teach or suggest Applicants' required element that the information medium consisting of at least one identification medium, an insert having high tear strength, and a protective casing which

surrounds at least the identification medium, is joined as a unit. For example, as Applicants state in the specification, “the identification medium remains securely attached over the entire duration of the use” and it “may be sewn, glued and/or riveted to the insert.” Applicants’ specification as originally filed at p. 3, second full paragraph and at p. 5, first full paragraph. In contrast, Brinkman teaches a label holder that holds labels or signs which can be inserted into a pocket and “replaced at will.” Brinkman at col. 6, lines 27-28. Liener Chin teaches that printed paper can “easily be corrected or changed” by printing another sheet of plain paper and inserting it into the sleeve.” Liener Chin at col. 3, ll. 24-28 and FIG. 23. Larsen teaches that “the indicia 24 and information contained in the blank area 26 may be conveniently changed by removing the pieces of paper with adhesive backings containing old information and replacing them with pieces of paper containing new information.” Larsen at col. 5, ll. 8-13. Therefore, each of the references not only fails to teach, but also **teaches away** from Applicants’ information medium consisting of at least one identification medium, an insert having high tear strength, and a protective casing which surrounds at least the identification medium, being joined as a unit.

With regard to claim 24, Brinkman, Liener Chin, and Larsen combined also fail to teach or suggest at least: (1) an information medium permanently attached to means for fastening, securing or clamping goods or for securing a person; and (2) the information medium consisting of at least one identification medium, an insert having high tear strength, and a protective casing which surrounds at least the identification medium, being joined as a unit, as explained above. Indeed, all three references teach away from these claimed elements of Applicants.

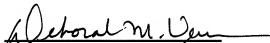
For at least the foregoing reasons, Brinkman, Liener Chin, and Larsen combined fail to teach or suggest at least two claimed elements in each of the two independent claims 1 and 24. Claims 2-23 depend upon claim 1. Accordingly, Applicants respectfully request the obviousness rejection to claims 1-24 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants respectfully submit that the Examiner has failed to establish a proper rejection under 35 U.S.C. § 103(a). Applicants respectfully request that all rejections be withdrawn. All pending claims are in condition for allowance and early favorable action is respectfully requested.

Should the Examiner find that there are any issues outstanding after consideration of this Request, the Examiner is welcome to contact Applicants' Attorney at the number below to expedite prosecution of the application.

Respectfully submitted,



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Date: July 10, 2009

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